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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/613,615

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Cheryl L. Neofytides

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EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/613,615

Applicant(s)

NEOFYTIDES ET AL.

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 91-148 is/are pending in the application.
- 4a) Of the above claim(s) 114-148 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 91-113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Prosecution History

This abbreviated prosecution history is presented to clarify the record.

On 11 July 2000, applicant filed this application. There are no claims to priority.

On 11 October 2001, the Examiner rejected original claims 1-29.

On 25 January 2002, applicant cancelled claims 1-29 and added claims 30-90.

On 27 March 2002, the Examiner issued a final rejection of claims 30-90.

On 26 July 2002, applicant requested continued examination. Applicant cancelled claims 38, 52-68, 76, 79-90. Applicant amended claims 30, 37, 40-46, 50-51, 69-70, 73-75 and 77-78. Claims 30-37, 39-51, 69-75 and 77-78 remained.

On 4 September 2002, the Examiner issued a non-final rejection of claims 30-37, 39-51, 69-75 and 77-78.

On 13 January 2003, applicant cancelled claims 69-78 and amended claim 30. Claims 30-37 and 39-51 remained.

On 28 February 2003, the Examiner finally rejected claims 30-37, 39-51.

On 23 April 2003, applicant filed a notice of Appeal.

On 27 June 2003, applicant filed an appeal brief regarding claims 30-37, 39-51.

On 12 November 2003, the application became abandoned for failure to respond.

On 8 December 2003, applicant submitted a petition to revive the application, as having been unintentionally abandoned.

On 10 December 2003, applicant was advised that the appeal brief was not entered because of lack of fees and absence of authorization to charge fees.

On 7 June 2004, the Office granted applicant's petition to revive.

On 13 January 2005, the Examiner rejected claims 30-37 and 39-51:

Claims 30-37, 39-46 and 50-51 were rejected under 35 USC 102(a) prior use of PAYPAL®, as evidenced by

- "You've Got Money!" Rene Wijnen, Bank Technology News, New York, June 2000, vol. 13, Issue 6, page 1.
- "Beaming Money by Email is Web's Next Killer App" PR Newswire, New York, November 16, 1999, page 1.

Claims 47-49 were rejected as unpatentable over PAYPAL® in view of Bills.com.

On 13 June 2005, applicant cancelled claims 30-37 and 39-51. Applicant added claims 91-148 and argued against the PAYPAL® and Bills.com references.

On 21 September 2005, the Examiner issued a restriction requirement for newly presented claims 91-148. Applicant did not receive this document.

On 28 September 2005, the undelivered requirement was returned to the PTO.

On 16 June 2006, the Office withdrew the Election/Restriction Requirement because the address had been changed without applicant's permission.

On 21 June 2006, the Examiner withdrew the requirement for species selection.

On 16 August 2006, applicant responded to the restriction requirement.

Response to Arguments

Applicant's amendment of 13 June 2005 has been entered.

Claims 91-148 are pending, of which claims 114-148 are withdrawn from prosecution as drawn to a non-elected invention.

Claims 91-113 will be examined.

Response to Arguments

Applicant's election with traverse of claims 91-113 in the reply filed on 16 August 2006 is acknowledged.

Applicant traverses on the ground(s) that there will be no appreciable burden on the Examiner to keep the claims together.

... These claims are sufficiently closely related that they should belong in the same patent. There will be no appreciable burden on the examiner or on the Office to keep these claims together (there are only 3 independent claims remaining in the case). A concise and simple explanation of the relationship of the claims is set out on page 16 of the "Amendment and Response to First Office Action in Reopened Prosecution" filed June 13, 2005. Indeed, the claims are so closely related that even the examiner could not find a more disparate classification than subclasses 64 and 75 of Class 705 (Business Processing Using Cryptography). It is noted that subclass 75 (transaction verification) is subsidiary in the class schedule to subclass 64 (secure transaction); any meaningful search of either of the alleged three groupings should include both of these subclasses.

... There is no good reason to further multiply the cost and inconvenience to the applicant in this case merely because a tenuous case for a restriction can be made.

The Examiner respectfully disagrees with applicant's comments that the searches would not be an "*appreciable burden*". The Examiner respectfully notes that the Office requires that Examiners search claims without limiting searches to particular classes and subclasses. Thus, any search must include various types of searches, including textual searches and image searches of all classes and subclasses in each of multiple databases of US patents, PG-PUBS, foreign patents, non-patent literature, the Internet and Internet archives.

Applicant also argues that the claims are sufficiently closely related that they should belong in the same patent.

However, the burden on the applicant, with this case having been on file for over six (6) years, is significant. All three independent claims in the case share certain elements in common, e.g. the address book feature, utilizing email for the

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communications between parties, registration of a payee to receive a payment, etc. Any art that is applied in rejecting the claims (if there is any viable art, which is not admitted and is expressly denied) will in all likelihood be relevant to patentability of all of the independent claims. Granted, there are distinguishing features between the independent claims, but they all share significant elements in common and properly belong in the same patent. [emphasis in original]

The Examiner respectfully disagrees and notes that applicant nowhere asserts that the various embodiments are obvious variations over another. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the invention to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant argues:

This case has been pending now for more than six years (!), has been the subject of an RCE, has been on appeal, was inadvertently abandoned and revived, had documents sent to the wrong address and nearly abandoned again, etc. The Office, and the applicant has [sic] expended considerable time and resources on this case. There is no good art that can be applied in this case--several examiners have handled the case and searched, and no good art has been found.

At the onset, the Examiner regrets inconveniences to applicant during prosecution.

However, Claims 91-148 have never been examined.

The restriction requirement is still deemed proper and is therefore made FINAL.

Applicant's comments, concerning cancelled claims 30-37 and 39-51 are moot in view of cancellation of those claims.

Information Disclosure Statement

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Applicant submitted identical statements on 13 June 2005 and on 16 June 2005.

The following appear to be word processing errors. Item 84's title is ***Beam Me up Some Cash***, not *Bring Me up Some Money*. Item 88 is 3 pages long, not 2, and item 93 is 3 pages long, not 2.

Item 95 appears to contain several references. Only the first was submitted:

##	Author	Title	pp	Pub. Date	Found on
95	UNKNOWN	Payment and Services from PaySys	2	unknown but believed to be after the filing of the present application,	www.paysys.com internet website and printed on Oct. 14, 2003
95.a	UNK	UNK	3	UNK	www.banktechnews.comlbtntlarticleslbt noctOI-13.shtml internet website and printed on Sep. 23, 2003

Claim Objections

Claim 110 refers to an ***address book*** and lacks antecedent basis. Previous claims refer various items that have the descriptive label ***address book***, e.g., ***address book database*** and ***address book record*** (claim 91) and ***address book display*** (claim 110). For purposes of Examination, claim 110 will be interpreted as "...each addressee in the address book ***database***..."

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 91-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gardyne, Allan, Introducing PayPal, 9 December 1999, downloaded from the Internet*

<http://www.associateprograms.com/articles/385/1/Introducing-PayPal> on 29 October 2006.

As per claim 91, Gardyne discloses computer implemented method(s) for providing a money transfer service between first party and a second party through a payment enabler system, comprising the steps of:

maintaining at the payment enabler system a **database of registered users** that have registered with the payment enabler system, the database comprising a plurality of records that include an email address and other account ("once you've joined" paragraph 32, data is stored in a database of users that have joined (registered));

maintaining at the payment enabler system an **address book database** for storing address book records comprising names associated with second parties with whom a first party may initiate a money transfer, each address book record including a name and an associated email address ("...as long as they are not already PayPal users, and have not been referred by someone else" paragraph 42);

in response to selection by a first party (a registered entity, as in paragraph 17) of an address book entry of a particular second party for purposes of initiating a money transfer with the selected second party, **retrieving the email address** associated with the selected second party from the first party's associated address book records in the address book database (see, for example, paragraph 17);

accessing the registered users database and determining whether the retrieved email address associated with the selected particular second party has a record in the registered users database (recipients need not be registered users, paragraph 18);

in response to a determination that the second party has no entry in the registered users database, **sending the second party** a registration invitation email utilizing the retrieved email address to notify the second party that a transaction is pending and instructing the second party to register with the payment enabler system by accessing the payment enabler system (see, for example, "you've Got cash!" paragraph 20);

in response to accessing of the payment enabler system by the second party after the registration invitation email, **conducting a user registration process** (see, paragraph 20, for example) comprising steps including

receiving registration information comprising an email address of the registering user, identification information (as in paragraph 20, for example);

in response to receiving registration information from a registering user, **creating a database record** in the registered users database including the registration information (recipients need not be registered users, paragraph 18); and

completing the transaction between the first party and the second party by the payment enabler transferring money between the first party and the second party utilizing a determined money transfer method (paragraph 20).

Gardyne **does not** specifically refer to a default payment method and a default money receiving method.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Gardyne default money payment and receiving methods. One of ordinary skill in the art at the time the invention was made would have

been motivated to include in Gardyne default money payment and receiving methods for the obvious reason that by storing and using this data, users do not have to enter the information each time they send or receive money.

As per claim 92, Gardyne discloses that *the* record in the registered users database includes security information provided by a first party, for association with a selected second party; and the step of completing the transaction is carried out in response to registration by the second party and provision of corresponding expected security response information from the second party (see paragraph 25, concerning security protocols).

As per claims 93 and 94, Gardyne **does not** specifically disclose

...that the security information provided by the first party is a question and the corresponding expected security response information from the second party comprises an expected answer (claim 93).

... that the user registration process further comprises the steps of receiving the security information provided by the first party; in further response to accessing the payment enabler system by the second party, providing a question corresponding to the security information to the registering user; and comparing a received response from the registering user to the corresponding expected security response information; and proceeding with the step of completing the transaction only if the received response matches the expected security response information (claim 94). Official Notice is taken that the use of security challenge questions was notoriously well known at the time the invention was made.

It would have been obvious to one of ordinary skill at the time the invention was made to combine Gardyne and knowledge of one of ordinary skill to disclose

...that the security information provided by the first party is a question and the corresponding expected security response information from the second party comprises an expected answer (claim 93).

... that the user registration process further comprises the steps of receiving the security information provided by the first party; in further response to accessing the payment enabler system by the second party, providing a question corresponding to the security information to the registering user; and comparing a received response from the registering user to the corresponding expected security response information; and proceeding with the step of completing the transaction only if the received response matches the expected security response information (claim 94).

One of ordinary skill at the time the invention was made would have been motivated to combine Gardyne and knowledge of one of ordinary skill to disclose

...that the security information provided by the first party is a question and the corresponding expected security response information from the second party comprises an expected answer (claim 93).

... that the user registration process further comprises the steps of receiving the security information provided by the first party; in further response to accessing the payment enabler system by the second party, providing a question corresponding to the security information to the registering user; and comparing a received response from the registering user to the corresponding expected security response information; and

proceeding with the step of completing the transaction only if the received response matches the expected security response information (claim 94).

For the obvious reason that using human language questions and verifiers permits users that are not comfortable with computers to obtain their money.

As per claim 95, Gardyne discloses that the transaction comprises a payment from the first party to the second party (paragraph 20).

As per claim 96, Gardyne discloses that the transaction comprises a request for a payment from the second party to the first party (paragraph 23, transaction types).

As per claim 97, Gardyne discloses the step of, in response to determination that a second party already has an entry in the registered users database, completing the transaction between first party and the second party (see, for example, paragraph 20).

As per claim 98, Gardyne discloses that the registration invitation email sent to the second party by the payment enabler system includes a link that directs the second party to registration web page associated with payment enabler system (paragraph 20).

As per claim 99, Gardyne discloses that transaction is a payment from the first party to the second party (paragraph 17, payments to merchants, business), and

wherein in further response to a determination that a second party has no entry in the registered users database, obtaining authenticating information from the first party prior to sending the registration invitation email (paragraph 18), and

storing the authenticating information in the registered users database in anticipation of registration by the second party (paragraph 20).

As per claim 100, Gardyne **does not** specifically disclose that authenticating information comprises a question to be asked of the registering user and an expected answer. Official Notice is taken that the use of security challenge questions was notoriously well known at the time the invention was made.

It would have been obvious to one of ordinary skill at the time the invention was made to combine Gardyne and knowledge of one of ordinary skill to disclose authenticating information comprises a question to be asked of the registering user and an expected answer.

One of ordinary skill at the time the invention was made would have been motivated to combine Gardyne and knowledge of one of ordinary skill to disclose authenticating information comprises a question to be asked of the registering user and an expected answer for the obvious reason that using human language questions and verifiers permits users that are not comfortable with computers to obtain their money.

As per claim 102, Gardyne discloses that user registration process further comprises the step of sending a registering user a confirmation email including a deep link operative for activating an account of the registering user with the payment enabler system (paragraph 20, linking and completing registration process)

As per claims 101, 103-105, Gardyne does not specifically disclose

... that user registration process comprises steps for allowing the registering user to select a default payment method from a plurality of payment methods, and a default money receiving method from a plurality of money receiving methods (claim 101)

... that the determined money transfer method comprises the default method for either making payment or receiving money (claim 103).

... that determined money transfer method comprises a selected alternate payment method instead of a default payment method (claim 104).

... that the determined money transfer method comprises a selected alternate money receiving method instead of a default money, receiving method (claim 105).

As per claims 101, 103-105, It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Gardyne

... that user registration process comprises steps for allowing the registering user to select a default payment method from a plurality of payment methods, and a default money receiving method from a plurality of money receiving methods (claim 101)

... that the determined money transfer method comprises the default method for either making payment or receiving money (claim 103).

... that determined money transfer method comprises a selected alternate payment method instead of a default payment method (claim 104).

... that the determined money transfer method comprises a selected alternate money receiving method instead of a default money, receiving method (claim 105).

One of ordinary skill in the art at the time the invention was made would have been motivated to include in Gardyne default money payment and receiving methods

... that user registration process comprises steps for allowing the registering user to select a default payment method from a plurality of payment methods, and a default money receiving method from a plurality of money receiving methods (claim 101)

... that the determined money transfer method comprises the default method for either making payment or receiving money (claim 103).

... that determined money transfer method comprises a selected alternate payment method instead of a default payment method (claim 104).

... that the determined money transfer method comprises a selected alternate money receiving method instead of a default money, receiving method (claim 105).

for the obvious reason that by storing and using this data, users do not have to enter the information each time they send or receive money.

As per claim 106, Gardyne discloses storing additional information associated with a money transfer, the additional information including transaction type information and status information (paragraph 20).

As per claim 107, Gardyne discloses that transaction type information is selected from the following: send, request, refund (paragraph 20, money is sent).

As per claim 108, Gardyne discloses that status information is selected from the group: fulfilled, canceled, pending (paragraph 23, payables and receivables).

As per claim 109, Gardyne discloses the step of providing an account history display including information corresponding to money transfers between a first party and a plurality of second parties, the account history display comprising, for each money transfer transaction, one or more of the following information items: a name, a reference number associated with the payment enabler system, an email address, an amount, a date, a transaction description, and the additional information (paragraph 23, payables and receivables).

As per claim 110, Gardyne does not specifically disclose disclosing providing an address book display for a party to select one or more particular second parties, the address book display comprising, for each addressee in the address book, one or more of the following information items: a selection box for selection, a name, an email address, and a number of transactions associated with the particular party. Official Notice is taken that in email systems, the use of address books and displays to select are notoriously well known.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gardyne and knowledge generally available to one of ordinary skill in the art at the time the invention was made to disclose providing an address book display for a party to select one or more particular second parties, the address book display comprising, for each addressee in the address book, one or more of the following information items: a selection box for selection, a name, an email address, and a number of transactions associated with the particular party.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Gardyne and knowledge generally available to one of ordinary skill in the art at the time the invention was made to disclose providing an address book display for a party to select one or more particular second parties, the address book display comprising, for each addressee in the address book, one or more of the following information items: a selection box for selection, a name, an email address, and a number of transactions associated with the particular party for the

obvious reason that doing so provides an additional ease of use feature which lowers errors.

As per claim 111, Gardyne discloses that the money transfer method comprises steps for an first money transfer from a payor to an intermediary and steps for a second money transfer from the intermediary to a payee (bank account, as in paragraph 20).

As per claim 112, Gardyne discloses the first money transfer steps are selected from the group: receiving a deposit of an amount of cash by the payor via a payment processor, debiting a credit card of the payor, debiting a bank account of the payor (paragraph 20), debiting a stored value account of the payor, and receiving a paper check from the payor.

As per claim 113, Gardyne discloses the second money transfer steps are selected from the group: debiting a bank account of the intermediary to fund dispensing of cash to the payee through an automated teller machine, dispensing cash to the payee by a payment processor, crediting a credit card of the payee, crediting a bank account of the payee, crediting a stored value card of the payee, and sending a paper check to the payee (paragraph 20, concerning bank account processing).

Allowable Subject Matter

Claim 109 would be allowable if rewritten in independent format to incorporate the limitations of the intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose nor reasonably suggest the step of

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providing an account history display including information corresponding to money transfers between a first party and a plurality of second parties, the account history display comprising, for each money transfer transaction, one or more of the following information items: a name, a reference number associated with the payment enabler system, an email address, an amount, a date, a transaction description, and the additional information.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Zurita
Primary Examiner
Art Unit 3625
29 October 2006

James Zurita
Primary Examiner